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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,656

Applicant(s)

BERNAT ET AL.

Examiner

Ross N. Gushi

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-14 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-4 and 15-18 is/are rejected.
- 7) ☐ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1, figures 1-5; species 2, figures 6-14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence¹ or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

During a telephone conversation with Attorney Soloway on January 17, 2003 a provisional election was made with traverse to prosecute the invention of species 1, claims 1-5 and 15-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-14 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to because the cross hatching does not conform to the guidelines as set out in MPEP section 608.02. In particular, the cross-hatching of the insulative portions (resin, plastic, etc.) of the assembly should be cross-hatched with alternating thick and thin diagonal lines.

Correction is required in response to this Office action and corrections may not be held in abeyance. Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in

ABANDONMENT of the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 16, "said jack contact of a plug in jack" lacks antecedent basis and is confusing and unclear. The term is interpreted as meaning "the jack contact of the plug in jack according to claim 1."

Regarding claims 15 and 17, the term "SMT connection" is vague and ambiguous. Applicant does not define what the abbreviation means in the specification and merely indicates that the a "SMT connection" is or allows "a surface mounting technique." The term is interpreted as meaning the that the retaining part is capable of being mounted on a surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jawelak in view of Evans. Jawelak discloses a plug in jack comprising a jack contact consisting of a retaining part 4 and a jack 2, said jack being mounted on the retaining part so as to be pivotable by a limited angle.

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Jawelak does not discuss whether the contact is in an insulating jack housing. Evans discloses insulating jack housing 56 enclosing pin 52 mounted on circuit board 54. At the time of the invention, it would have been obvious to accommodate the Jawelak contact in an insulating housing as taught in Evans. The suggestion or motivation for doing so would have been to protect the contact from damage and prevent the contact from being accidentally shorted, as taught in Evans implicitly and as is well known in the art.

Per claim 2, said retaining part comprises a head portion, an adjoining annular groove and a collar adjoining said annular groove and wherein said Jack comprises spring shackles engaging with said annular groove.

Per claim 3, the shackles have free ends provided with one hook on each of the free ends.

Per claim 4, the jack is barrel shaped with is provided with contact shackles at an end opposite the hook.

Per claim 15, the retaining part is capable of being mounted on a surface.

Regarding claims 16 and 17, Jawelak does not show the details of the plug part except for the plug in portion 22. Evans discloses a plug in part including housing 56 and a contact capable of mating the jack contact discussed regarding claim 1, the plug contact including a plug in portion, and anchor portion and a surface mountable connection portion. At the time of the invention, it would have been obvious to use a plug part as disclosed by Jawelak with the jack part discussed regarding claim 1. The

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suggestion or motivation for doing so would have been to connect one device to another, as taught by Evans.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Regarding claims 5 and 18, the prior art does not suggest the assembly as claimed, including the combination of all the claimed elements, the combination including that the collar is adjoined by an anchor groove followed by an anchor portion, an annular spring being accommodated in the anchor groove, its edge facing the collar being beveled and a diameter of said collar and the head (or plug in portion) of said retaining part being less than a diameter of said anchor portion.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 308-7766

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